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04/09/2004

Robert F. Snapp

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22852

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07/01/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT

PAPER NUMBER

3628

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,796	<b>Applicant(s)</b> SNAPP ET AL.	
	<b>Examiner</b> AKIBA K. ROBINSON BOYCE	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7,9-19,21,22,24-34,36,37 and 39-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,9-19,21,22,24-34,36,37 and 39-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Due to communications filed 4/15/10, the following is a final office action. Claims 1, 16, 31 have been amended. Claims 5, 8, 20, 23, 35, 38 are cancelled. Claims 1-4, 6-7, 9-19, 21-22, 24-34, 36-37, and 39-45 remain pending in this application and have been examined on the merits. The previous rejection has been modified to reflect claim amendments.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case, the limitation regarding "wherein the alternate delivery point code contains the same number of digits as the normal delivery point code" is considered new matter. Negative limitations need explicit support in the specification-MPEP 2173.05(i) "Any negative limitation or exclusionary provision must have basis in the original disclosure". The mere absence of a positive recitation is not basis for an exclusion.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-4, 6-7, 9-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-4, 6-7, 9-15 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process must either: (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 1-4, 6-7, 9-15 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if

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recited machine or transformation constitutes mere "insignificant post- solution activity."

(In re Bilski, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post- solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO's "Guidance for Examining Process Claims in view of In re Bilski" memorandum dated January 7, 2009, [http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski\\_guidance\\_memo.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf).

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Exparte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fdO81495.pdf>.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-7, 12-22, 27-37, 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (US 5,901,214), and in further view of Fleckenstein et al (US 2004/0211834 A1), and further in view of Wilson et al (US 2006/0031213 A1).

As per claims 1, 31, Shaffer et al discloses:

receiving delivery data corresponding to a delivery point; determining if the delivery data includes a secondary element, (Col. 11, lines 34-40, further subdivide delivery point code (DPC) using USPS secondary address, where receiving is inherent with Shaffer et al since the delivery data must first be received in order to process by subdividing); and

creating a normal delivery point code when the delivery data does not include a secondary element, (col. 11, line 35, DPC before it further subdivided); and

creating the alternative delivery point code when the delivery data includes the secondary element, wherein the creating comprises calculating, based on the secondary element, a number, and setting at least one digit of the alternative delivery point code to the calculated number, (Col. 11, lines 34-43, further subdivide the DPC using the USPS secondary address to create *a unique housing or business unit identifier* [suggests the random number], and then appending the secondary address to the end of the DPC results in an extended 19 digit USPS ZIP Code, thereby creating a unique housing unit or business unit identifier, where in this case, the random number represented by the unique housing or business unit identifier is used to set the alternative delivery point code to a new unique housing unit or business unit identifier going from an 8 digit to a 19 digit zip code).

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Shaffer et al does not specifically disclose one of a random number or a pseudo-random number, however suggests this limitation since the unique number created for the secondary address contains a portion of the DPC, and therefore has no specific pattern, thereby suggesting that the unique number is random.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to incorporate random or pseudo-random numbers in a postal system with the motivation of using numbers with no specific pattern to create unique postal identifiers.

Shaffer et al does not disclose wherein the alternate delivery point code contains the same number of digits as the normal delivery point code, however, Fleckenstein et al discloses in [0013] "a method for modifying the delivery of one or more unique items each intended for delivery at a first location and each having a unique identity and each item having a different machine-readable item code. The method includes the steps of providing a delivery modification authorization at the first location having a unique alternate delivery code thereon. The alternate delivery code is read from the delivery modification authorization and then the item code from at least one of the items is read. The alternate delivery code is then linked with the item code. Stored alternate delivery information regarding the item is then read in response to receipt of a description of the delivery modification authorization from a delivery agent. Delivery plans of the item are modified based upon said stored alternate delivery information". In this case, examiner interprets the item code having a unique identity as the normal delivery point code, and the alternate delivery code as the alternate delivery point code, where in this case since

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the item code is never changed, but delivery plans only modified according to linked instructions, thereby suggesting that the alternate delivery point code contains the same number of digits as the normal delivery point code. In addition, Fleckenstein et al discloses in [0024] "FIGS. 3A and 3B are the first and second sides, respectively, of a delivery notice 20 according to an embodiment of the present invention. The notice in one embodiment is a piece of paper printed on both sides. The first side includes a machine-readable (first) delivery notice code 21, which corresponds to a human-readable (second) delivery notice code 22, which is in this case numerals, although it could be alphanumeric or any human readable format."

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the alternate delivery point code contains the same number of digits as the normal delivery point code with the motivation of changing delivery plans without changing the delivery code format.

Neither Shaffer et al nor Fleckenstein et al specifically disclose when the secondary element contains alphanumeric data, converting the alphanumeric data to numeric data/wherein the calculating further includes converting first numeric data into different numeric data, however, Wilson discloses describes a level of pre-processing that obtains an 11-digit delivery point code (DPC) that is used to access the data stores and retrieve associated address information, as shown in [0006], and also discloses wherein standardizing includes at least one of converting alphabetical representations of numbers in the second identifier component to numeric values, removing spaces in the second identifier component, and standardizing abbreviations in the second



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identifier component as shown in claim 36 of Wilson et al. It therefore would be obvious to combine the teachings of Shaffer et al and Wilson to disclose wherein the calculating further includes converting alphanumeric data to numeric data/wherein the calculating further includes converting first numeric data into different numeric data.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to disclose wherein the calculating further includes converting alphanumeric data to numeric data/wherein the calculating further includes converting first numeric data into different numeric data with the motivation of showing that processing involving the alternative delivery point code includes transformation of values.

As per claim 2 Shaffer et al discloses:

wherein the secondary element comprises at least one of a fractional number, a trailing alpha, a descriptor, and a secondary number, (Col. 11, lines 37-40, secondary address is stored as an eight character field).

As per claims 3 , 4, 18, 19, 33, 34, Shaffer et al discloses:

further comprising creating a normal delivery point code based upon the delivery data if the delivery data does not include the secondary element/ wherein the normal delivery point code comprises the two right-most digits in a primary address number of the delivery point, (col. 11, lines 44-45, 19 digit zip code).

As per claims 6, 21, 36, Shaffer et al discloses:

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wherein creating the random number further comprises initializing an alphanumeric field with blanks and a numeric field with zeros, the three element alphanumeric field comprising a first alphanumeric element, a second alphanumeric element, and a third alphanumeric element, and the three element numeric field comprising a first numeric element, a second numeric element, and a third numeric element, (Col. 49, lines 1-5, leading zero/blank character/"123").

As per claims 7, 22, 37, Shaffer et al discloses:

wherein creating the random number further comprises storing data associated with the secondary element in one of the three element alphanumeric field and the three element numeric field, (Col. 49, lines 32-49, shows use of records).

As per claims 12, 27,42, Shaffer et al does not specifically disclose the following:

wherein the random prime number is 47.

However, the nature of the facility and its particular industry is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

As per claims 13, 28, 43, Shaffer et al discloses:

wherein the normal delivery point code associated with the delivery point comprises the two right-most digits in a primary address number of the delivery point, (col. 11, lines 44-45, 19 digit zip code).

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As per claims 14, 29, 44, Shaffer et al discloses:

wherein the alternative delivery point code is numeric, (Col. 49, lines 1-5,"123").

As per claims 15, 30, 45, Shaffer et al discloses:

wherein the alternative delivery point code comprises one of two digits and two alphanumeric characters, (Col. 49, lines 1-5,numeric fields/fields containing a letter)) .

As per claim 16, Shaffer et al discloses:

a memory storage for maintaining a database, (col. 2, lines 30-33, information retrieval, processing and storage/databases); and

a processing unit coupled to the memory storage, (Col. 2, lines 30-33, information processing and storage), wherein the processing unit is operative to

receive delivery data corresponding to a delivery point; determine if the delivery data includes a secondary element, (Col. 11, lines 34-40, further subdivide delivery point code (DPC) using USPS secondary address, where receiving is inherent with Shaffer et al since the delivery data must first be received in order to process by subdividing); and

create the alternative delivery point code based upon the secondary element if the delivery data includes the secondary element, wherein the creating comprises calculating, based on the secondary element, one of a random number or a pseudo-random number and setting at least one digit of the alternative delivery point code to the calculated number (Col. 11, lines 34-43, further subdivide the DPC using the USPS secondary address to create *a unique housing or business unit identifier* [suggests the random number], and then appending the secondary address to the end of the DPC

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results in an extended 19 digit USPS ZIP Code, thereby creating a unique housing unit or business unit identifier, where in this case, the random number represented by the unique housing or business unit identifier is used to set the alternative delivery point code to a new unique housing unit or business unit identifier going from an 8 digit to a 19 digit zip code).

Shaffer et al does not specifically disclose one of a random number or a pseudo-random number, however suggests this limitation since the unique number created for the secondary address contains a portion of the DPC, and therefore has no specific pattern, thereby suggesting that the unique number is random.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to incorporate random or pseudo-random numbers in a postal system with the motivation of using numbers with no specific pattern to create unique postal identifiers.

Shaffer et al does not disclose wherein the alternate delivery point code contains the same number of digits as the normal delivery point code, however, Fleckenstein et al discloses in [0013] "a method for modifying the delivery of one or more unique items each intended for delivery at a first location and each having a unique identity and each item having a different machine-readable item code. The method includes the steps of providing a delivery modification authorization at the first location having a unique alternate delivery code thereon. The alternate delivery code is read from the delivery modification authorization and then the item code from at least one of the items is read. The alternate delivery code is then linked with the item code. Stored alternate delivery

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information regarding the item is then read in response to receipt of a description of the delivery modification authorization from a delivery agent. Delivery plans of the item are modified based upon said stored alternate delivery information". In this case, examiner interprets the item code having a unique identity as the normal delivery point code, and the alternate delivery code as the alternate delivery point code, where in this case since the item code is never changed, but delivery plans only modified according to linked instructions, thereby suggesting that the alternate delivery point code contains the same number of digits as the normal delivery point code. In addition, Fleckenstein et al discloses in [0024] "FIGS. 3A and 3B are the first and second sides, respectively, of a delivery notice 20 according to an embodiment of the present invention. The notice in one embodiment is a piece of paper printed on both sides. The first side includes a machine-readable (first) delivery notice code 21, which corresponds to a human-readable (second) delivery notice code 22, which is in this case numerals, although it could be alphanumeric or any human readable format."

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the alternate delivery point code contains the same number of digits as the normal delivery point code with the motivation of changing delivery plans without changing the delivery code format.

Neither Shaffer et al nor Fleckenstein et al specifically disclose wherein the calculating further includes converting first numeric data in the secondary element to different numeric data, however, Wilson discloses describes a level of pre-processing

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that obtains an 11-digit delivery point code (DPC) that is used to access the data stores and retrieve associated address information, as shown in [0006], and also discloses wherein standardizing includes at least one of converting alphabetical representations of numbers in the second identifier component to numeric values, removing spaces in the second identifier component, and standardizing abbreviations in the second identifier component as shown in claim 36 of Wilson et al. It therefore would be obvious to combine the teachings of Shaffer et al and Wilson to disclose converting first numeric data in the secondary element to different numeric data.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to disclose converting first numeric data in the secondary element to different numeric data, with the motivation of showing that processing involving the alternative delivery point code includes transformation of values.

As per claims 17, 32, Shaffer et al discloses:

wherein the secondary element comprises at least one of a fractional number, a trailing alpha, a descriptor, and a secondary number, (col. 49, lines 1-2).

### ***Allowable Subject Matter***

8. Claims 9-11, 24-26, 39-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-4, 6-7, 9-19, 21-22, 24-34, 36-37, and 39-45 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for

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the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

•Patent Application Information Retrieval (PAIR) system, Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A. R. B.  
July 1, 2010

/Akiba K Robinson-Boyce/

Primary Examiner, Art Unit 3628